

## REMARKS

5 The Office Action dated 05/28/2008 indicates claims 1-20 are pending for the above referenced application, and claims 1-20 are subject to a restriction requirement. Furthermore, the Office Action states the following:

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-4, and 20, drawn to a stacked pad for processing substrates.

Group II, claim(s) 5-19, drawn to a method of chemical mechanical polishing substrates.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature of a stacked pad having a top pad and a subpad wherein the hardness or modulus of the top pad substantially equals the hardness or modulus of the subpad, though shared between all inventions does not define a contribution which each of the claimed inventions considered as a whole, makes over the prior art. Shih et al. (U.S. 6,409,587) discloses a pad for processing substrates which has a top pad and a subpad wherein the hardness of the top pad and the sub pad are substantially the same (C5, L55-67, the top pad has a hardness value of 60 and the bottom pad has a hardness value of 50, which are substantially the same as in the instant specification's preferred embodiment on page 5, lines 20-30).

To comply with the Office Action, Applicant elects Group II, claims 5-19, drawn to a method of chemical mechanical polishing. This election of invention is being made with traverse.

5           The present restriction requirement is inappropriate for several reasons such as:

1. The present patent application is a national phase United States application filed under 35 USC 371 from International Application PCT/US2004/033591. In Chapter 1 of the PCT process, a search was performed for all of the claims and an international  
10   search report was prepared. The claims in the PCT application are identical to the claims considered in making the restriction requirement. A copy of the international search report was submitted in an IDS for the instant application on 08/10/2006. At no time during the PCT international phase was there any indication that the number of inventions covered by the claims was unacceptable. It is Applicant's understanding that  
15   the claims met the requirements for unity of invention. Consequently, the present restriction requirement is inappropriate. Reconsideration and withdrawal of the restriction requirement is respectfully requested.

2. The Office Action suggests that Shih et al., US 6,409,587 discloses a pad that is  
20   substantially the same as Applicant's pad. However, the summary of Shih et al.'s teachings as presented in the Office Action is not sufficiently complete and leads to an inappropriate conclusion. A more detailed analysis shows that Shih et al. teaches a dual-hardness polishing pad for use in linear chemical mechanical polishing. The first material of Shih et al.'s pad may have a hardness not lower than 60 and the second  
25   material may have a hardness not higher than 50. Shih et al.'s teachings are clearly different from the teachings for one of Applicant's preferred embodiments. According to one of Applicant's preferred embodiments, the top pad has a Shore D hardness of about 50-60 and the subpad has a Shore D hardness of about 50-60 (see citations presented in the Office Action). There are other differences between the teachings of Shih et al.  
30   and Applicant's teachings, however a detailed analysis of the differences may not be

appropriate for a response to a restriction requirement but will be presented if needed in an office action on the merits.

3. Since a search has been done for all of the claims as part of Chapter 1 of the PCT process, there is not an undue burden for the examiner in considering both inventions in the present application. For further support see MPEP 808.02 where it states

“Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.”

### **Claim Amendments**

Minor amendments have been made to claims 5-10 and 15 to remove the unnecessary wording “steps of” or “step of” etc. The preamble to claims 5 and 15 have been amended to include the phrase “and/or planarization” so as to avoid unnecessarily narrowing the interpretation of the scope of the claims. No new matter has been added to the claims. Support for the claim amendments can be found in the originally filed specification (page 4, lines 12-14; page 6, lines 12-28; page 7; and the Abstract).

### Conclusions

It is hereby respectfully submitted that this response meets the requirements of  
5 the Office Action and places the above named patent application in condition for further  
examination and allowance. Reconsideration and withdrawal of the restriction  
requirement is respectfully requested. Please telephone the undersigned at (707) 523-  
7530 if there are any questions regarding this matter.

10 Respectfully submitted,



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